Election / #15
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On 13 Sept. 2002

TOWNSEND and TOWNSEND and CREW LLP

By: Malinda Dwight

PATENT
Attorney Docket No.: 015280-343100US
Client Ref. No.: E-029-98/1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Examiner: Misook Yu
RYBAK and NEWTON	Art Unit: 1642
Application No.: 09/622,613	RESPONSE TO RESTRICTION REQUIREMENT
Filed: August 17, 2000	
For: RECOMBINANT ANTI-TUMOR RNASE	

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement mailed August 13, 2002, Applicants elect Group I, claims 1-19 and 34-44, drawn to a ribonuclease with specific amino acids at the specified positions.

In response to the species election requirement, Applicants elect SEQ ID NO:2. The claims that read on the elected species are claims 1-19 and 34-44.

The election is made with traverse, as the three Groups set forth by the Examiner stem from a common concept and theory, and are thus related. Accordingly, examination of the claims together would not impose an undue burden on the Examiner.

In particular, Applicants submit that the species election requirement, particularly with regard to the ribonucleases set forth in claim 1, is not proper, as it prevents examination of the invention as defined by the Applicants.

The invention defined in claim 1 is not limited to a single SEQ ID. However, by imposing the species election, the Examiner is not examining that which applicants regard as their invention. This is improper (*see, e.g.,* MPEP§803.02). As the C.C.P.A. noted with regard to restriction practice:

> As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. *In re Weber, Soder and Boksay,* 198 USPQ 328, 331 (C.C.P.A. 1978). *See also In re Haas,* 179 USPQ 623, 624-625 (C.C.P.A. 1973) (*In re Haas I*); and *In re Haas,* 198 USPQ 334, 334-337 (C.C.P.A. 1978) (*In re Haas II*). *See also* MPEP § 803.02.

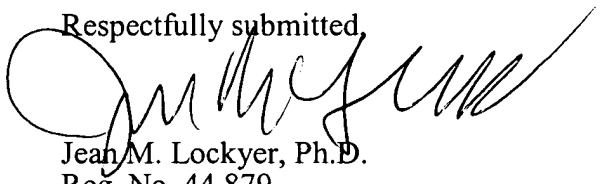
In the cases set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *In re Weber*:

> The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-no matter how broad, which means no matter how many independently patentable inventions may fall within it.
> *In re Weber,* 198 USPQ at 334.

Therefore, in refusing to examine claim 1 in its totality, *i.e.* effectively rejecting claim 1, the Examiner is improperly rejecting the claims. Applicants therefore respectfully request reconsideration of the election requirements.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned.

Respectfully submitted,



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